

REMARKS

The Office Action dated October 19, 2009, has been carefully reviewed and the foregoing Amendment has been made in consequence thereof.

Claims 1-5 and 7-22 are now pending in this application. Claims 1-5 and 7-21 stand rejected. Claim 22 is newly added. No additional fee is due for newly added Claim 22.

The rejection of Claims 1-5 and 7-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0060266 to Baerlocher (hereinafter referred to as "Baerlocher") in view of U.S. Patent 6,620,046 to Rowe (hereinafter referred to as "Rowe") is respectfully traversed.

Initially, Applicant respectfully traverses the assertion on page 3 that Baerlocher describes "presenting a pre-selected wager threshold to the player (0061-0062, wherein the threshold is presented in the game which is being utilized by the player)...." Moreover, Applicant respectfully traverses the assertion that Baerlocher describes "displaying a pre-stored trigger on the display (figure 1, element 56)...." Rather, Applicant respectfully submits that at paragraph [0061], Baerlocher describes that "one method 200 *requires* the player to wager a number of credits to qualify or be eligible for the 'main' bonus game." (Emphasis added.) Moreover, at paragraph [0062], Baerlocher describes that "[i]n the wager or credit embodiments, requiring a number of credits to be wagered requires the player to wager the credits on any number of paylines 56." In addition, at paragraph [0042], Baerlocher element 56 of FIG. 1 is defined merely as a payline. As such, Applicant submits that nowhere does Baerlocher describe nor suggest *presenting*, to the player, the number of credits that must be wagered by the player to be eligible for a bonus game. Applicant submits that presenting a preselected wager threshold differs from merely requiring a number of credits to be wagered. For example, paragraph [0046] of Applicant's specification provides the following examples of methods that may be used to present a preselected wager threshold:

The gaming machine can include signage to communicate to the player what the wager threshold for entering the secondary game is . . . To encourage a player who has not met the threshold to increase his wager, casinos can inform the player that the threshold has not been met, and can invite him to increase his wager in order to gain access to the secondary game. This information can be communicated to the player through audio associated with a gaming machine . . . an indicator light on the gaming machine, through a display associated with a gaming machine . . . or through a printer 212 associated with the EGM 10 . . . Additional examples of how the threshold level can be communicated to one or more players include: the use of overhead signs, through public address, through vouchers, mailings, handouts, electronic devices, or personal digital assistants. (Emphasis added.)

Accordingly, Applicant respectfully submits that Baerlocher does not describe nor suggest *presenting* a preselected wager threshold to a player as is recited in Claim 1, or *displaying* a prestored trigger as is recited in Claim 7. Rather, Baerlocher merely describes *requiring* a certain number of credits to be wagered.

It appears that the present rejection reflects an impermissible attempt to use the instant claims as a guide or roadmap in formulating the rejection using impermissible hindsight reconstruction of the invention. It is also impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The United States Supreme Court has recently expressed concern regarding distortion caused by hindsight bias in an obvious analysis, and notes that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning.” KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1742, 82 USPQ2d at 1397. *See also Ex parte Rinkevich*, 2007 WL 1552288 (Bd. Pat. App. & Interf. May 29, 2007).

Following the Supreme Court’s guidance provided in *KSR* with respect to impermissible hindsight, a person of ordinary skill in the art, having common sense at the time of the invention, would have no reason to combine Baerlocher and Rowe to arrive at Applicant’s claimed invention, as combining these two references would render at least one

of Baerlocher and Rowe inoperable as described. Baerlocher requires that a player have wagered a certain number of credits *and* have obtained a bonus trigger during play of a base game. Rowe requires that a player meet eligibility rules such as a minimum wager per game or over time to be eligible for a bonus game. Applicant submits that combining Baerlocher and Rowe would render at least one of Baerlocher and Rowe inoperable as described because, for example, Baerlocher requires both a certain wager and a certain result, and Rowe does not require a certain result but does require a player meet eligibility rules such as a minimum wager per game or over time. Accordingly, Applicant submits that one of ordinary skill in the art would not combine Baerlocher and Rowe because removing the result requirement of Baerlocher would render Baerlocher inoperable as described.

Baerlocher describes a gaming method that requires a player at a gaming device (10) to wager a number of credits to qualify or be eligible for a main or first bonus game. The gaming device (10) determines whether a bonus triggering symbol or symbol combination (hereinafter referred to as a “bonus trigger”) for the first bonus game appears along a payline (56) or in a scatter arrangement. If the bonus trigger for the first bonus game is generated, the gaming device (10) determines whether the player has wagered at least a first predefined number of credits. If so, the gaming device (10) initiates the first bonus game. If the bonus trigger is generated, but the player has not wagered at least the first predefined number of credits, the gaming device (10) determines whether the player has wagered at least a second predefined number of credits, which is less than the first predefined number. If so, the gaming machine (10) initiates a second bonus game. In addition, if the bonus trigger is not generated but a second, different bonus trigger for the second bonus game has been generated, and at least the second predefined number of credits has been wagered, the gaming device (10) initiates the second bonus game.

Rowe describes a bonus system (50) that includes a gaming machine (20) that is coupled to other devices through a communication network (58), including other gaming machines (20) and a player tracking or reward system host (54). The gaming machine (20) includes a player tracking device including a card reader (34) and/or a keypad (44). The host (54) provides a player tracking reward or “comp” function in which players that use player

tracking cards are awarded with prizes based on, for example, a number of points accrued by using the player tracking card during play. The bonus system (50) determines eligibility of players to participate in a bonus event based on, for example, play of a specific gaming machine or type of gaming machine, wagering of a particular amount, an amount won or lost, a particular point total in a player's reward account, whether the player has identified himself via the host (54), and the like. The bonus event is enabled for eligible players, and winning players are then awarded with a bonus prize.

Claim 1 recites a method for controlling access to a secondary game on a gaming machine during play of a primary game, wherein the method comprises "presenting a preselected wager threshold to a player . . . accepting a wager from the player via a gaming machine input device . . . comparing, via a processor, the accepted wager to the preselected wager threshold . . . initiating the secondary game, by the gaming machine, when the accepted wager equals the preselected wager threshold, wherein initiation of the secondary game is based only on the comparison of the accepted wager to the preselected wager threshold and regardless of an outcome of the primary game . . . reporting the outcome for play of the primary game via a gaming machine primary indicator and an outcome for play of the secondary game via a gaming machine secondary indicator."

No combination of Baerlocher and Rowe describes nor suggests a method for controlling access to a secondary game, as recited in Claim 1. More specifically, no combination of Baerlocher and Rowe describes nor suggests presenting a preselected wager threshold to a player. Rather, Baerlocher describes requiring a number of credits to be wagered, and automatically initiating one of a number of bonus games based on detection of a particular bonus trigger and a wager of the required number of credits, and Rowe describes determining eligibility for participation in a bonus and awarding a bonus independent of a specific outcome of a base game.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Baerlocher in view of Rowe.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-5 likewise are patentable over Baerlocher in view of Rowe.

Claim 7 recites a system for allowing secondary play on a gaming machine having a primary game and a secondary game, wherein the system comprises “a monitor configured to display a prestored trigger to a player . . . a determiner structured to compare a wager to the prestored trigger . . . a controller coupled to the determiner and structured to initiate the secondary game responsive to a signal received from the determiner, wherein initiation of the secondary game by the controller is based only on the comparison of the wager to the prestored trigger regardless of either a timing of the comparison of the wager to the prestored trigger and an outcome of the primary game, said controller further structured to report at least one of the outcome for play of the primary game and an outcome for play of the secondary game.”

No combination of Baerlocher and Rowe describes nor suggests a system for allowing secondary play on a gaming machine, as recited in Claim 7. More specifically, no combination of Baerlocher and Rowe describes nor suggests a monitor configured to display a prestored trigger to a player. Rather, Baerlocher describes requiring a number of credits to be wagered, and automatically initiating one of a number of bonus games based on detection of a particular bonus trigger and a wager of the required number of credits, and Rowe describes determining eligibility for participation in a bonus and awarding a bonus independent of a specific outcome of a base game.

Accordingly, for at least the reasons set forth above, Claim 7 is submitted to be patentable over Baerlocher in view of Rowe.

Claims 8-15 depend from independent Claim 7. When the recitations of Claims 8-15 are considered in combination with the recitations of Claim 7, Applicant submits that dependent Claims 8-15 likewise are patentable over Baerlocher in view of Rowe.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-5 and 7-15 be withdrawn.

The rejection of Claims 16-21 under 35 U.S.C. § 103(a) as being unpatentable over Baerlocher in view of Rowe, and further in view of U.S. Patent Publication No. 2002/0142846 to Paulsen (hereinafter referred to as "Paulsen") is respectfully traversed.

Baerlocher and Rowe are described above. Paulsen describes a user interface (50) for use in modifying a player preference account. The user interface (50) may be displayed on a computing device such as a gaming machine (2) or a home computer. The user interface (50) may be used by a player to create and modify a preference account that includes preference account information corresponding to one or more game playing options preferred by the player. The user interface (50) may also be used by a game operator or a preference account administrator to create and modify preference accounts for game players. The preference account information may include, for example, loyalty point account information and settings, preferred promotional opportunities, preferred games and game feature settings for the games, preferred gaming machine settings, preferred bonus games, preferred progressive games, and preferred service options.

Claim 16 recites a method of initiating a secondary game on a gaming machine during play of a primary game, wherein the method comprises "determining whether a player is enrolled in a player tracking system . . . presenting to the player one of a first predetermined threshold and a second predetermined threshold that is different than the first predetermined threshold, wherein the first predetermined threshold only applies to players enrolled in the player tracking system and wherein the second predetermined threshold applies to players not enrolled in the player tracking system . . . accepting a wager via a gaming machine input device . . . comparing, by a processor, the wager to the one of the first and second predetermined thresholds . . . permitting play on a secondary game using the gaming machine when the wager equals one of the first predetermined threshold when it is determined that the player is not enrolled in the player tracking system, and the second predetermined threshold when it is determined that the player is enrolled in the player tracking system, wherein permission to play the secondary game is based only on the comparison of the wager to one

of the first and second predetermined thresholds regardless of a timing of the comparison of the wager to one of the first and second predetermined thresholds....”

No combination of Baerlocher, Rowe, and Paulsen describes nor suggests a method of initiating a secondary game on a gaming machine, as recited in Claim 16. More specifically, no combination of Baerlocher, Rowe, and Paulsen describes nor suggests presenting to a player one of a first predetermined threshold and a second predetermined threshold that is different than the first predetermined threshold, wherein the first predetermined threshold only applies to players enrolled in a player tracking system and wherein the second predetermined threshold applies to players not enrolled in the player tracking system. Rather, Baerlocher describes requiring a number of credits to be wagered, and automatically initiating one of a number of bonus games based on detection of a particular bonus trigger and a wager of the required number of credits, Rowe describes determining eligibility for participation in a bonus and awarding a bonus independent of a specific outcome of a base game, and Paulsen describes a user interface for use in creating and modifying a preference account for a game player that includes preference account information corresponding to one or more game playing options preferred by the player.

Accordingly, for at least the reasons set forth above, Claim 16 is submitted to be patentable over Baerlocher in view of Rowe and Paulsen.

Claims 17-20 depend from independent Claim 16. When the recitations of Claims 17-20 are considered in combination with the recitations of Claim 16, Applicant submits that dependent Claims 17-20 likewise are patentable over Baerlocher in view of Rowe and Paulsen.

Claim 21 recites a system for accessing a secondary game during play of a primary game, wherein the system comprises “a plurality of gaming machines that each comprises: a data input device configured to accept a wager from a player . . . a monitor configured to display one of a first wager threshold and a second wager threshold that is different than the first wager threshold . . . a server coupled to the plurality of gaming machines, wherein said server comprises: a player tracking determiner configured to determine whether the player is

enrolled in a player tracking system based on signals received from said player tracking device . . . a comparator configured to: compare the wager to the one of the first and second wager thresholds, wherein the wager is compared to the first wager threshold if the player is not enrolled in the player tracking system, and wherein the wager is compared to the second wager threshold if the player is enrolled in the player tracking system . . . generate a signal to initiate a secondary game based only on the comparison of the wager to one of the first and second wager thresholds, wherein the comparison of the wager to one of the first and second wager thresholds occurs regardless of at least one of an outcome of the primary game, and a timing of the comparison of the wager to one of the first and second wager thresholds.”

No combination of Baerlocher, Rowe, and Paulsen describes nor suggests a system for accessing a secondary game, as recited in Claim 21. More specifically, no combination of Baerlocher, Rowe, and Paulsen describes nor suggests a plurality of gaming machines that each includes a monitor that displays one of a first wager threshold and a second wager threshold that is different than the first wager threshold, wherein the first wager threshold applies to players enrolled in a player tracking system and wherein the second wager threshold applies to players not enrolled in the player tracking system. Rather, Baerlocher describes requiring a number of credits to be wagered, and automatically initiating one of a number of bonus games based on detection of a particular bonus trigger and a wager of the required number of credits, Rowe describes determining eligibility for participation in a bonus and awarding a bonus independent of a specific outcome of a base game, and Paulsen describes a user interface for use in creating and modifying a preference account for a game player that includes preference account information corresponding to one or more game playing options preferred by the player.

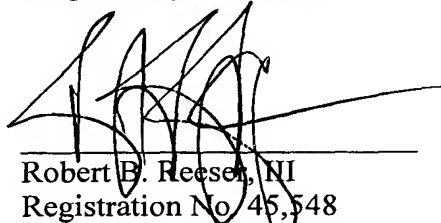
Accordingly, for at least the reasons set forth above, Claim 21 is submitted to be patentable over Baerlocher in view of Rowe and Paulsen.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 16-21 be withdrawn.

Newly added Claim 22 depends from independent Claim 1. When the recitations of Claim 22 are considered in combination with the recitations of Claim 1, Applicant submits that Claim 22 likewise are patentable over the cited art.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action are respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert B. Reeser, III', is written over a horizontal line.

Robert B. Reeser, III
Registration No. 45,548
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070